

REMARKS/ARGUMENTS

The final Office Action of May 15, 2007 has been carefully reviewed and these remarks are responsive thereto. Claims 1, 8-10, 16, and 20 have been amended, claim 29 has been cancelled, and no new claims have been added. Applicants submit that these claim amendments are fully supported by the specification, and thus introduce no new matter to the application. Claims 1, 3-6, 8-10, 12-16, 18-28, and 30-33 are pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1, 5-6, 8-10, 12-16, 19-28, 30, and 33 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of U.S. Patent No. 5,680,636 to Levine et al. (*Levine*), in view of U.S. Patent No. 5,146,552 to Cassorla et al. (*Cassorla*). Applicants respectfully traverse this rejection for at least the following reasons.

Amended claim 1 recites, “determining whether the currently displayed page of the electronic document is associated with an existing annotation file that is stored separately from the electronic document.” Then, if it is determined that the current page is associated with an existing annotation file, claim 1 recites, “retrieving the separately stored annotation file and displaying annotations corresponding to previously stored annotation stroke data on the computer display device.” Alternatively, if it is determined that the current page is not associated with an existing annotation file, claim 1 recites, “creating a new annotation file stored separately from the electronic document.” Support for these recited features can be found, e.g., at page 10, lines 13-17, of the specification as originally filed.

Levine relates to annotating an electronic document, but as the Office Action correctly states on page 5, *Levine* does not teach an annotation file stored separately from the electronic document. Thus, *Levine* does not teach or suggest determining if a current document or document page is associated with a separate annotation file. Nor does it teach retrieving and displaying annotations from a separate annotation file, or creating a separate annotation file for a currently displayed document or document page, as recited in amended claim 1.

Cassorla discloses text-based annotations that may be stored in files separate from the

original document. (Abstract; Col. 5, lines 8-30) Specifically, *Cassorla* describes storing annotations and related information in a separate file (Col. 5, lines 8-30), and then allowing users to review past annotations and to identify the location of the individual annotations within the original document. (Col. 5, lines 31-53) *Cassorla* also describes allowing multiple users the opportunity to review and make additional annotations onto the document. (Col. 7, lines 56-64) However, *Cassorla* does not teach or suggest “determining whether the currently displayed page of the electronic document is associated with an existing annotation file,” as recited in amended claim 1.

To illustrate this distinction, *Cassorla* at column 7, lines 16-64, describes a first user that annotates an electronic document on his workstation and then provides the annotations to a second user to review and supplement. However, as stated in this example, *Cassorla* requires that the first user, “command his workstation to transmit the formatted text stream 26 and the annotation string records 28’, 32’ and 36’ over his communications adapter 48 and the connecting network to the workstation of user 2.” (Col. 7, lines 32-35) Thus, at most, *Cassorla* discloses displaying an electronic document and annotations from an associated annotation file only after the user has identified and opened the both electronic document and the separate annotation file. There is no indication or suggestions that *Cassorla* discloses any technique for “determining whether the currently displayed page of the electronic document is associated with an existing annotation file,” as recited in amended claim 1.

Therefore, Applicants submit that neither *Levine* nor *Cassorla*, alone or in combination teaches or suggests, “determining whether the currently displayed page of the electronic document is associated with an existing annotation file that is stored separately from the electronic document,” and “if the currently displayed page is associated with an existing annotation file, retrieving the separately stored annotation file and displaying annotations corresponding to previously stored annotation stroke data on the computer display device,” or “if the currently displayed page is not associated with an existing annotation file, creating a new annotation file stored separately from the electronic document,” as recited in amended claim 1. Accordingly, amended claim 1 is not obvious in view of the proposed combination. Claims 5-6,

8-9, 21-23, 30, and 33 depend from claim 1 and are allowable for at least the same reasons as claim 1, as well as based on additional features recited therein.

Independent claim 10 has been amended to recite a system for annotating electronic documents comprising computer software to perform steps similar to those recited in claims 1. Accordingly, claim 10, and dependent claims 12-15 and 24-26 are allowable for at least the same reasons as claim 1.

Independent claim 16 has been amended to recite a computer-readable storage medium comprising computer-executable instructions for performing steps similar to those recited in claims 1. Accordingly, claim 16, and dependent claims 19-20 and 27-28 are allowable for at least the same reasons as claim 1.

Claims 3-4, 18, and 31-32 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of *Levine*, in view of *Cassorla*, and further in view of U.S. Patent No. 5,920,694 to Carleton et al. (*Carleton*). *Carleton* relates to annotations of a video display by different users on multiple different computers, and also discloses storing the annotations separate from the electronic document. However, like *Cassorla*, *Carleton* also appears to require that a user transfer or provide the annotated document to the editor for incorporation of the annotations into the document. (Col. 15, lines 18-30) Therefore, *Carleton* also fails to teach or suggest, “determining whether the currently displayed page of the electronic document is associated with an existing annotation file,” and “if the currently displayed page is associated with an existing annotation file, retrieving the separately stored annotation file and displaying annotations corresponding to previously stored annotation stroke data on the computer display device,” or “if the currently displayed page is not associated with an existing annotation file, creating a new annotation file stored separately from the electronic document,” as recited in amended claim 1. Thus, *Carleton* fails to overcome the deficiencies of *Levine* and *Cassorla* discussed above, and for the same reasons stated above, claims 3-4, 18, and 31-32 are allowable over the combination of *Levine*, *Cassorla*, and *Carleton*.

Application No. 09/455,805
Amendment dated August 14, 2007
Reply to Office Action of May 15, 2007

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3324.

Respectfully submitted,

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